

REMARKS

Claims 33-163 are currently pending in this application.

Interview Summary

On September 14, 2005, Examiner Harrell and his supervisor and applicant's attorney had an interview with respect to this application and the other co-pending applications claiming priority from the same parent application. With respect to the 35 USC 112, first paragraph rejection, it was clarified that an expert affidavit regarding enablement could be from an in-house engineer. As noted in the Examiner's Interview Summary of September 21, 2005 for application no. 09/862,622, the affidavit of Jeffrey Morgan to overcome the Wolf reference was discussed. The Examiner stated that the Exhibit lab notes were focusing on the software aspects of web servers.

Information Disclosure Statement

An information disclosure statement is filed herewith, including references previously cited in an Information Disclosure Statement submitted on June 24, 2005 which were not included in the Examiner's office action of July 29, 2005.

Title of the Invention

The title of the invention has been amended again to "Embedding a Web Server Into a Device for Accessing and Controlling Device Functionality by a User Interface Functioning Over a Network" as suggested by the Examiner in the Office Action with a mailing date of May 7, 2004.

References to Co-pending applications

The specification has been amended to reference co-pending applications 09/721,409, 09/862,230, 09/862,622, 09/862,804, 09/863,300, 09/863,368, 09/863,667, 09/865,347 and 09/865,977 listed in the May 7, 2004 office action.

Rejection of Claims 33-163 under 35 USC 112 First Paragraph

Applicant submits the enclosed expert declaration entitled "Declaration of Keith Moore in Support of Enablement of the Claims of the Above-Identified Application," to overcome the Examiner's rejection under 35 USC 112 as suggested in the Office Action of July 29, 2005.

Rejections of Claims 33-163 under either 35 USC 102(e) or 35 USC 103(a) based on Huntsman (US 5,801,689) and Wolff (US 6,209,048) either alone or in a combination with another reference

Applicant submits Declarations under 37 C.F.R. 1.131 made by each of the co-inventors, Jeffrey A. Morgan and Chandrasekar Venkatraman, to swear behind each of Huntsman and Wolff. It is respectfully submitted that the Declarations by the Inventors shows that the invention disclosed and claimed in this application was both conceived and reduced to practice in the United States of America prior to the earlier effective date of January 22, 1996 of Huntsman. It is therefore respectfully requested that the Huntsman and Wolff references be removed from further consideration as prior art references under 35 USC 102 or 103.

Rejection of Claims 33-163 under 35 USC 102(e) as being anticipated by Gosling (US 6,618,754)

Gosling is directed to a method of networked devices registering with each other and requesting and receiving executable versions of software programs or code fragments, for example by using Java with which the Gosling inventors came up rather than having to have these executable locally compiled and available. Gosling describes its invention as "an improvement over compound document transmission capabilities provided by current networks." Col. 1, lines 11-13. Gosling provides two example network contexts for the application of exchanging executable code fragments responsive to requests. However, although the two network environments are presented as capable of using the transmission of executable programs method described, Gosling does not disclose the two network contexts as equivalents.

See col. 8 lines 5 to 19. These code fragments are "binary code for an embedded application that is executable on the controller 122 and attributes related to the binary

code.” Four types of executable programs of the embedding applications or code fragments (col. 2, line 44) are described:

“(1) output code that, when executed, produces a visual or audible manifestation (e.g. graphical or sound simulations), (2) meta-knowledge code that can advise a user regarding legal interactions with the document in which the code fragment was embedded, (3) contextual code that can sense and indicate the processing context of the compound document in which the code fragment was embedded; and (4) handlers for embedded data.” Col. 2, lines 51-59.

In order for the system of Gosling to work, each device must register with the name server in order to receive and send requested software applications from other devices in the network. See col. 6, lines 46-58.

“In this automatic installation process, as soon as the user plugs in a new enclosure, the new enclosure’s controller 112 “wakes up” and begins operating under control of its operating system 116.1. Recognizing its “new” status, the operating system 116.1 asks its associated name server 119 to register the enclosure. In response, that name server 119 broadcasts on the network the name and address of the new enclosure to the other enclosures connected to the network. Upon receiving this message, the name servers running on the controllers 112 and 122 in the other enclosures register the new enclosure by updating their name server registries with the new device’s network address and name.”

Gosling assumes a common infrastructure exists such as the Java virtual machine and a name server for a plurality of devices to communicate with each other to request applications identified as being on those other devices. See col. 7 lines 11-24, “In addition to storing addresses of all enclosures on the network, each name server 119, 134 lists the names and internal address of all of the documents (including compound documents, flat files and code fragments) that are stored in its memory 116, 126 and

possible other relevant documents stored on other network nodes. This information allows the controller 122 to easily locate documents (for sending or displaying)."

Gosling itself distinguishes between the example contexts.

"*Aside* (emphasis added) from the use of embedded applications in Web pages, other uses for embedded documents within networks of computer controlled devices are apparent. For example, in home entertainment systems, where there are multiple components, each with a unique user interfaces (sic) (typically unintuitive), documents with embedded application capabilities could be adapted to provide a highly adaptable universal remote control." Col. 2, lines 26-34.

With the "Aside" language and noting that the devices each have a unique user interface, along with distinguishing the discussion of web servers and web pages as an alternative embodiment (col. 11, line 40) in which "the system and method of the preferred embodiment is also applicable to networks of computers," col. 11, lines 47-48, Gosling is emphasizing that the context of the web server/web page example is not the same as the home network. The enclosures and the web servers are not interchangeable. Again, the commonality between the two network examples is their ability to use the same executable program exchange system and method between devices in a network, be they the described enclosures of Figure 1 or server computers of Figure 6. The capabilities of a browser downloading and running (without compiling) executable code fragments that are referenced or embedded in Web documents are the key features described in Gosling and are further described in col. 11, line 64 to col. 12, line 7 which provides examples of making a Web page more dynamic by being able to retrieve executable code and run it immediately.

Therefore, Gosling fails to disclose at least "the web server being embedded in the copier" or a web server being embedded in any of the other devices claimed in any of the other independent claims 50, 61, 72, 87, 98, 109, 120, 131, 142 or 153.

Claims 34-49

Furthermore, Gosling fails to disclose "a communication path coupled to

the network interface;" and "a web browser coupled to the communication path for rendering the copier web page." Thus in addition to the failure to disclose an embedded web server as discussed for claim 33, Gosling also fails to teach the communication path coupled to a web browser, and thus besides failing to teach claim 33 also fails to teach claims 34-49. Furthermore, additional features of these dependent claims are not inherent so they are not anticipated by Gosling, for example a "home-based network [which] includes twisted pair communication links" of claim 35, nor the "power line communication links" of claim 37, nor the "infrared communications links" of claim 39 nor the "telephone lines and cellular telephone links" of claim 40 nor the "serial communication links" of claim 41 nor the "parallel communication links" of claim 42 nor whether the "communication path is a direct Internet connection to the world-wide web" as in claim 43 nor whether the communication path includes a "communication bridge" as in claims 44 and 45.

Additionally, for the reasons discussed above, Gosling fails to disclose "a web browser coupled to the communication path for rendering the copier web page," and thus fails to disclose claim 33 and thus claims 46 to 49 depending therefrom. Furthermore, Gosling discusses a web browser in the context of a network of computers and not as being "embodied in specialized television hardware" as in claim 48 nor as being "embodied in specialized telephone system hardware" as in claim 49.

The arguments for claims 34-49 are also applicable to claims 51-60, 62-71, 73-86, 88-97, 99-108, 110-119, 121-130, 132-141, 143-152, and 154-163; therefore, they are also not disclosed by Gosling. Gosling fails to anticipate claims 33-163; and therefore it is respectfully requested that the rejection be withdrawn.

Rejection of Claims 33-163 under 35 USC 103(a) as being unpatentable by Gosling (US 6,618,754)

As discussed above, Gosling fails to disclose one or more elements including "a web server being embedded in the copier" of claim 33 or in any of the devices specified in the other independent claims. The concept of the web server being embedded is not disclosed in Gosling. Furthermore, the presentation of the example

network contexts in Figure 1 and Figure 6 in Gosling as separate environments itself illustrates that one of ordinary skill would not be motivated to combine the teachings with respect to Figure 1 with those of Figure 6 to make the claimed invention of the independent claims. The description of the two embodiments as separate environments with different requirements (See col. 2, lines 26-34) teaches away from combining them to form the claimed invention including a web server embedded in a device such as a copier or a printer or any of the other devices of the independent claims that generates a device specific web page and which is coupled to a network interface embedded in the device and to a monitor embedded in the device for controlling device specific functions. Gosling treats the examples of Figures 1 and 6 as separate contexts for allowing network devices to exchange executable programs or flat files responsive to a request from another identified network device when that network device needs the requested program or file. As discussed above, this system and method for transmission of requests for and responses of executable programs based on tracking what programs each device has is not the same as the subject matter discussed in independent claims 33, 50, 61, 72, 87, 98, 109, 120, 131, 142 or 153.

Additionally as discussed above, claims 34-49, 51-60, 62-71, 73-86, 88-97, 99-108, 110-119, 121-130, 132-141, 143-152, and 154-163 are also not disclosed by Gosling. The arguments for non-obvious applicable to the independent claims are also applicable to these claims which depend from them. Furthermore, Gosling discloses a universal remote controller controlling devices and a network of computers including web servers and web browsers. Although things like communication bridges and serial or parallel links may have been available in 1996, Gosling does not teach or suggest guidelines or considerations in configuring a network communication path. Therefore, the motivation to make or use the elements of dependent claims 35, 37, 39, 40, 41, 42, 43, 44 or 45 and their counterparts in 51-60, 62-71, 73-86, 88-97, 99-108, 110-119, 121-130, 132-141, 143-152, and 154-163 is lacking. Additionally, the web browser of claims 48 and 49 are not disclosed nor is there any discussion of the advantages and disadvantages of how the web browsers in Figure 6 can be embodied. Thus, Gosling lacks motivation to select the specific features described in claims 48 and 49 and their counterparts in 51-60, 62-71, 73-86, 88-97, 99-108, 110-119, 121-130, 132-141, 143-152, and 154-163

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from general knowledge to combine with the browser in Gosling. Of course, even if one did combine the communication path or web browser of Figure 6 with the specific features, the result would not be the subject matters as claimed in claims 33-163 as discussed above.

Gosling fails to teach or suggest or motivate one of ordinary skill in the art to make or use the subject matter of claims 33-163. Thus, claims 33-163 are patentable over Gosling under 35 USC 103(a); therefore, it is respectfully requested that this rejection be withdrawn.

Conclusion

In light of the arguments presented above, pending claims 33-163 as previously amended are in condition for allowance, and applicants respectfully request a prompt notice of allowance.

Date:

6/26/06

Respectfully Submitted on Behalf of Applicants

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